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EXAMINER	
MCCULLOCH JR, WILLIAM H	

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3714	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/684,353	PACEY, LARRY J.	
	Examiner	Art Unit	
	WILLIAM H. MCCULLOCH JR	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to amendments received 11/19/2007. Claims 1-35 are pending in the application, with claims 1, 7, 17, 23, and 29 currently amended, and claims 30-35 newly added.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the present instance, claim 31 (from which claim 34 depends) recites the initial limitation "the first award credits being greater than the outcome credits", and the claim 34 recites "the outcome credits being greater than the first award credits" which is inconsistent with the limitations imposed by claim 31. Appropriate correction is required. The Examiner notes that Applicant may have intended for claim 34 to depend from claim 28, which is how the claim will be interpreted for purposes of this examination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 17-19 and 21-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,620,045 to Berman et al. (hereinafter Berman). This rejection was made in a previous Office Action and is maintained herein.

Regarding claim 17, Berman describes a method of conducting a wagering base game comprising: receiving a wager to play the wagering base game (see at least 8:15-24 and 9:49-10:10); determining an outcome to the wagering base game (see at least 8:15-24 and 9:49-10:10); concealing from the player the outcome to the wagering base game (e.g., concealing the outcome from the player while reels are spinning, as was noted in the previous rejection); providing a first award option to a player, the first award option displayed on a video display of the gaming machine (see at least fig. 7 and description thereof); and in response to the first award option being exercised by the player, precluding the player from receiving the winning credits and awarding the first award option to the player (see at least 9:49-10:47).

Regarding claim 18, Berman teaches that a first award option comprises base game play not requiring a wager (see at least 2:3-15 and 9:49-10:47).

Regarding claim 19, Berman teaches a first award option further comprising a credit amount, as is demonstrated by the outcome of a bonus game payable with a number of credits (see *Id.*)

Regarding claims 21 and 22, Berman teaches a first bonus award option comprises bonus award credits, the bonus award credits being greater than the first credit award (see at least 15:18-27).

6. Claims 1, 23, 30, 33, and 35 are rejected under 35 U.S.C. 102(e) as being by U.S. 6,659,864 to McGahn et al. (hereinafter McGahn).

Regarding claims 1 and 23, McGahn teaches a method of and gaming machine for conducting a wagering base game (see at least 7:10-13) comprising: a video display for displaying video images associated with the wagering base game; and a controller operatively coupled to the value input device and the video display, the controller comprising a processor and a memory coupled to the processor (see at least fig. 2); receiving a wager from a player to play the wagering base game (see at least 5:9-22); determining an outcome to the wagering base game; concealing, from the player, the outcome to the wagering base game and an outcome pay out associated with the outcome (e.g., the enticement and consolation awards; see at least 7:41-8:17); displaying, to the player, a keep pay option on a video display without showing the outcome and the outcome pay out (see at least figs. 3-4); displaying, to the player, a first award option on the video display of the gaming machine (e.g., the initial award; see at least 7:41-8:17); and receiving, from the player, a selection of either the keep pay option or the first award option, the selection of the keep pay potion awarding the player the outcome pay out and precluding the player from receiving the first award option, and the selection of the first award option awarding the player the first award option and precluding the player from receiving the outcome pay out (see at least 7:41-8:17).

Regarding claims 30 and 33, McGahn teaches wherein the first award option is more valuable or less valuable than the outcome pay out (see at least 7:41-8:17).

Regarding claim 35, McGahn teaches displaying the outcome and the outcome pay out to the player after the step of receiving a selection from the player (see at least figs. 3-5 and descriptions thereof).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 7 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGahn in view of U.S. 5,855,514 to Kamille (hereinafter Kamille).

McGahn describes displaying an option award meter on the video display, the option award meter providing a visual indication of a first award option value (see at least table 712 of fig. 7). McGahn lacks in explicitly teaching displaying an animated character on the video display wherein the animated character appears to give verbal instructions to the player. In a related disclosure, Kamille shows animated characters that appear to give verbal instructions to a player (see at least fig. 7B and related descriptions). It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of McGahn such that the instructions displayed on the display are given by an animated character, as is taught by Kamille, in order to increase overall player interactivity.

9. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berman in view of U.S. 5,855,514 to Kamille (hereinafter Kamille).

Berman describes displaying a keep pay option on the video display, wherein selection of the keep pay option allows the player to keep the winning credits and precludes the player from exercising the option (see at least fig. 7 and 9:49-10:47); and displaying an option award meter on the video display, the option award meter providing a visual indication of a first award option value (see at least table 712 of fig. 7). Berman lacks in explicitly teaching displaying an animated character on the video display wherein the animated character appears to give verbal instructions to the player. In a related disclosure, Kamille shows animated characters that appear to give verbal instructions to a player (see at least fig. 7B and related descriptions). It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of Berman such that the instructions displayed on the display are given by an animated character, as is taught by Kamille, in order to increase overall player interactivity.

10. Claims 2-6, 9-16, 24-28, 31, 32, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGahn in view of Berman.

Regarding claims 2, 10, and 24, McGahn teaches the invention substantially as described above, and further teaches wherein the gaming machine is a video slot machine (see at least 4:55-5:8). McGahn lacks in explicitly teaching wherein the first award option comprises at least one free reel spin. Berman shows such a limitation to have been well known in the art at the time of invention (see at least fig. 7, 2:3-15, and 9:49-10:47). The citation further shows that Berman teaches a first award option that comprises an occurrence of a bonus game. It would have been obvious to one of

ordinary skill in the art at the time of invention to modify McGahn to incorporate limitations of Berman in order to provide desirable bonus activities to players, which is shown to be essential by Berman in at least 2:3-51.

Regarding claims 3 and 25, Berman teaches that a first award option comprises base game play not requiring a wager (see at least 2:3-15 and 9:49-10:47).

Regarding claims 4 and 26, Berman teaches a first award option further comprising an occurrence of a multiplied winning outcome associated with the base game play not requiring a wager (see at least multiplier values in element 712 of fig. 7).

Regarding claims 5 and 27, both McGahn and Berman teach a first award option further comprising a credit amount, as is demonstrated by the outcome of a bonus game payable with a number of credits (see above).

Regarding claims 6 and 28, Berman teaches a first award option further comprising an occurrence of at least one enhanced symbol associated with the base game play not requiring a wager (see at least 2:3-15 and 6:7-13).

Regarding claims 9 and 12, Berman teaches a first bonus award option comprises bonus award credits, the bonus award credits being greater than the first credit award (see at least 15:18-27). McGahn also teaches each of the above limitations, as described regarding claims 30 and 33.

Regarding claim 11, Berman further describes a bonus game comprising: providing a plurality of pick tiles on the video display, each of the plurality of pick tiles associated with a hidden credit award (see at least 2:15-20); detecting player selection of a first pick tile of the plurality of pick tiles, player selection of the first pick tile

revealing a first credit award to the player (see at least 2:15-20); providing a first bonus award option to the player (see at least fig. 7 and 9:49-10:47); and in response to the first bonus award option being exercised by the player, precluding the player from receiving the first credit award and awarding the first bonus award option to the player (see at least 9:49-10:60). McGahn also teaches each of the above limitations, as described regarding claim 1.

Regarding claim 13, Berman teaches precluding the player from selecting a second pick tile of the plurality of pick tiles in response to the first bonus award option being exercised by the player. Berman teaches such by virtue of the fact that the player may choose one of the pick tiles, which may prompt the player to select an award or an award option, thereby precluding the player from selecting a second pick tile if the player exercises the option. McGahn also teaches each of the above limitations, as described regarding claim 1.

Regarding claim 14, Berman teaches in response to the first bonus award option not being exercised by the player, enabling player selection of the second pick tile, the second pick tile associated with a second credit award. Berman teaches such by virtue of the fact that the player may continue pick tile selection. Claims 15 and 16 follow from claims 13 and 14 because they are a continuation of the method of allowing a player to choose an award (the sum or accumulation of credits) or a further award option. See above. McGahn also teaches each of the above limitations, as described regarding claim 1.

Regarding claims 31 and 34, McGahn teaches wherein the outcome pay out comprises outcome credits and the first award option comprises first award credits being greater than or less than the outcome credits (see at least 7:41-8:17).

Regarding claim 32, McGahn teaches wherein the outcome is a non-winning outcome and the outcome pay out has no value (see at least 7:10-13).

11. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over McGahn in view of Kamille and in view of U.S. 6,569,015 to Baerlocher et al. (hereinafter Baerlocher).

McGahn in view of Kamille teaches the invention substantially as described above, but lacks in explicitly teaching an option award meter comprising a circular disk having a plurality of colored wedges and a rotatable pointer, each of the plurality of colored wedges associated with a different value, the rotatable pointer indicating one of the plurality of colored wedges. In a related disclosure regarding offering players different awards, Baerlocher teaches an option award meter comprising a circular disk having a plurality of colored wedges and a rotatable pointer, each of the plurality of colored wedges associated with a different value, the rotatable pointer indicating one of the plurality of colored wedges (see at least fig. 4 and descriptions thereof). It would have been an obvious matter of design choice to one of ordinary skill in the art at the time of invention to modify the device of McGahn in view of Kamille by incorporating the circular disk taught by Baerlocher in order to clearly demonstrate to a player the outcome of a bonus game.

Response to Arguments

12. Applicant's arguments with respect to claims 1-16 and 23-35 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments with respect to claims 17-22 have been fully considered but they are not persuasive. Amended claim 17 differs from the previous claim 17 in that it now recites "determining an outcome to the wagering base game". Berman clearly teaches determining an outcome to the wagering base game, as is described above. Applicant appears to equate the amendment to claim 17 with that of other independent claims 1 and 23 (which are addressed above in their own right), which is incorrect. Claim 17's recitation of "concealing from the player the outcome to the wagering base game" was addressed in the previous grounds of rejection and does not include the same limitations put forth by amended claims 1 and 23 that were agreed to overcome the previous rejection over Berman alone (namely, that the outcome is concealed while the gaming device offers a player an award option and displays the outcome after the player makes a selection). In summary, claim 17 has not been amended to overcome the previous grounds of rejection and therefore the previous rejection is maintained.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WILLIAM H. MCCULLOCH JR whose telephone number is (571) 272-2818. The examiner can normally be reached on M-F 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. H. M./
Examiner, Art Unit 3714
2/4/2008

/Robert E Pezzuto/
Supervisory Patent Examiner, Art Unit 3714